

Pleas cancel claim 2 without prejudic .

3. (AMENDED) The laminable photochromic element of claim [2] 1 consisting of three layers, [comprising] the photochromic layer and the two sandwiching layers, the two sandwiching layers comprising a polymer selected from the group consisting of polycarbonate resin and polysulfone resin.

13. (AMENDED) A method of forming a multi-layer polymeric photochromic article comprising securing the laminable [article] photochromic element of claim 1 to a polymeric article.

14. (AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating [a] one of said two polymeric [layer] layers of the laminable [article] photochromic element of claim [2] 1 to a polymeric article.

15. (AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating [a] one of said two polymeric [layer] layers of the laminable [article] photochromic element of claim 3 to a polymeric article.

16. (AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating [a] one of said two polymeric [layer] layers of the laminable [article] photochromic element of claim 4 to a polymeric article.

17. (AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating [a] one of said two polymeric [layer] layers of the laminable [article] photochromic element of claim 5 to a polymeric article.

Please cancel claim 18 without prejudice.

SUMMARY OF THE REJECTIONS

Rejections Under 35 USC 112, Second Paragraph

Claims 3, 9 and 13-19 have been rejected under 35 USC 112, second paragraph. The issues raised in this rejection comprise:

- a) It is asserted that the recitation of "consisting of" in line 1 of claim 3 is legally inconsistent with the recitation of "comprising" in line 2.
- b) Claims 13-19 recite the limitation of "laminable article" for which insufficient antecedent basis in the claims is asserted.
- c) The phrase "the polymeric layer" bridging lines 3 and 4 is asserted to be indefinite as there are two polymeric layers.

Rejections Under 35 USC 102(e)

Claims 1 and 8 have been rejected under 35 USC 102(e) as anticipated by Bowles et al. III (hereinafter "Bowles").

Rejection Under 35 USC 103(a)

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia et al. (U.S. Patent No. 5,757,459) in view of Ormsby et al. (U.S. Patent No. 4,889,413).

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia in view of Rosthauser et al. (U.S. Patent No. 6,107,395).

RESPONSE TO THE REJECTIONS

Rejections Under 35 USC 112, Second Paragraph

Claims 3, 9 and 13-19 have been rejected under 35 USC 112, second paragraph. The issues raised in this rejection comprise:

- a) It is asserted that the recitation of "consisting of" in line 1 of claim 3 is legally inconsistent with the recitation of "comprising" in line 2.

Claim 3 has been amended to remove this objectionable language.

- b) Claims 13-19 recite the limitation of "laminable article" for which insufficient antecedent basis in the claims is asserted.

Claim 13 has been amended to reflect the appropriate term for "laminable photochromic element" of claim 1. This rejection is moot.

- c) The phrase "the polymeric layer" bridging lines 3 and 4 is asserted to be indefinite as there are two polymeric layers.

The claims have been amended as suggested by the Examiner to reflect that it is one of the two polymeric layers that is laminated.

Rejections Under 35 USC 102(e)

Claims 1 and 8 have been rejected under 35 USC 102(e) as anticipated by Bowles et al. III (hereinafter "Bowles").

Claim 1 has been amended to recite the limitations of claim 2. As noted in the fact that claim 2 was not rejected under 35 USC 102(b), that claim requires the sandwiching of the photochromic layer with the two polymeric layers. That is not possible in the structure of Bowles where the coating with the photochromic compound is sprayed or otherwise coated onto the surface of a lens that might be a polycarbonate.

As the term "laminable" is described in the specification, that term also would not apply to the article of Bowles where the coating of the photochromic material is made onto the surface of a molded lens, not a moldable film.

Rejection Under 35 USC 103(a)

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia et al. (U.S. Patent No. 5,757,459) in view of Ormsby et al. (U.S. Patent No. 4,889,413).

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia in view of Rosthauser et al. (U.S. Patent No. 6,107,395).

Both of these rejections suffer from the same defect. Although Bhalakia shows a structure that is laminable to a lens, having a polarizing layer sandwiched between two polymeric layers, that is not suggestive of the presently claimed invention, even with the teachings of the two references. Bhalakia requires the use of the laminate system for applying polarizing layers to the surface of a lens blank prior to molding because the stress on polarizing layers was disruptive of the quality of the polarizing qualities of the layer. As that layer

needed to be oriented, it could not be coated onto the outer surface of a lens or lens blank from a solution.

The Bowles reference shows that the art recognized that the problems addressed by Bhalakia were believed to be not needed in the use of photochromic materials. Bowles showed that photochromic layers had already been successfully applied directly to lens after molding by coating of the solution onto the lens (e.g., spin coating). The problem to be solved by Bhalakia was therefore not seen to exist in the prior art.

Applicants recognized that the use of a laminable sandwich structure with a photochromic intermediate layer solved another, previously unrecognized set of problems. The coating method of Bowles could not consistently provide uniformity or design of the photochromic coating to a molded lens surface. Liquid applied coatings could tend to uncontrolled color variance across the surface of the lens, the desired gradation of density from the middle of the lens to the exterior could not be uniformly controlled, and the application of liquid coatings could not easily be limited to a single surface, so that cleaning or grinding might be needed.

As this problem was not recognized by any of the pairs of references used in the rejection, and as there is no suggestion in any reference of providing laminable photochromic sandwiches, nor of laminating any form of photochromic layers to a lens blank, the art of record fails to teach that the invention as whole is obvious to one skilled in the art. The rejection is in error and should be withdrawn.

• Authorization is hereby given to charge any additional fees or credit any overpayments that may be deemed necessary to Deposit Account Number 50-1391.

Respectfully submitted,

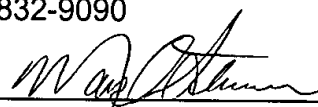
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By Their Representatives,

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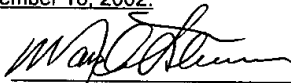
By:



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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Letter is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on December 18, 2002.

Mark A. Litman
Name


Signature